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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/540,991	12/14/2005	Fraser Harvie	00167-490US1	9555
26166 7590 10/02/2008 FISH & RICHARDSON P.C. SMITH & NEPHEW, INC. 150 Minuteman Road Andover, MA 01810				
EXAMINER				
LEWIS, RALPH A				
ART UNIT		PAPER NUMBER		
3732				
MAIL DATE		DELIVERY MODE		
10/02/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/540,991

Applicant(s)

HARVIE ET AL.

Examiner

Ralph A. Lewis

Art Unit

3732

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24, 28, 29, 45, 46 and 50 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24, 28, 29, 45, 46 and 50 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/35108)
Paper No(s)/Mail Date 7/25/2005, 6/28/2005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____

Obvious-type Double Patenting Rejections

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-24, 28, 29, 45, 46 and 50 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-102 of U.S. Patent No. 6,620,185. Although the conflicting claims are not identical, they are not patentably distinct from each other because one of ordinary skill in the art would have found the present claims obvious in view of those already patented. Moreover if allowed, would improperly extend the "right to exclude" already granted in the patent. For example pending claim 1 is a broader version of patented claim 87, merely eliminating elements from the patented claim and reciting other patented elements in lightly different terms would have been obvious to the ordinarily skilled artisan.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of

the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claims 1-3, 6-9, 11-22, 28, 29, 45 and 46 are rejected on the ground of nonstatutory double patenting over claims 1-58 of U. S. Patent No. 7,144,414 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter. Pending claim 1, for example, is the same as the patented claim 1, except that the heating element has been eliminated from the pending claim. The patenting of broader generic claims after a patent has already been granted improperly extends the right to exclude.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Statutory Double Patenting

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 4 and 5 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1 and 4 of prior U.S. Patent No. 7,144,414. This is a double patenting rejection.

Rejections based on Prior Art

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3 and 16-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Hannam et al (5,649,959).

Hannam et al disclose a surgical instrument for tissue fixation comprising a handpiece 46, piercing element (column 6, line 47), cannulated tube 26 mounted on handpiece 46 and defining a lumen, and delivery device 32 for delivering fixation member 30 and flowable material 54, 56. Note further suture control feed mechanism 38, probe 38, reservoir 33 and mixing device 33. In regard to claim 3, note the supply of suture 36 within the handpiece. The broad manner in which the apparatus is claimed leaves it open to any number of interpretations.

Claims 1-24, 28, 29, 45, 46 and 50 are rejected under 35 U.S.C. 102(e) as being anticipated by Harvie et al (US 6,620,185).

It is noted that the present application does not claim priority back to the 09/604,387 application (6,620,185 patent) and that the earlier patent has a different inventive entity from the present application.

Claims 28 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Weller (US 3,744,921).

Weller discloses a handpiece 12 having a cannulated tube 16 and heating device 34

Claim 50 is rejected under 35 U.S.C. 102(b) as being anticipated by Chervitz et al (US 5,665,110).

Chervitz et al disclose a method wherein an opening (14, 15, 16) is formed in bone 10, a fixation device (suture 17, 18, 19) is positioned in the opening, a flowable adhesive material (24) is delivered to opening and then cured (changing the state) to secure the fixation device in the opening.

Prior Art

Applicant's information disclosure statements of July 25, 2005 and June 28, 2005 have been considered and initialed copies enclosed herewith.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication should be directed to **Ralph Lewis** at telephone number **(571) 272-4712**. Fax (571) 273-8300. The examiner works a compressed work schedule and is unavailable every other Friday. The examiner's supervisor, Cris Rodriguez, can be reached at (571) 272-4964.

R.Lewis
September 29, 2008

/Ralph Lewis/
Primary Examiner, AU 3732